

Remarks

After careful consideration of the outstanding Office Action, this application has been amended accordingly, and favorable reconsideration on the merits thereof is at this time respectfully requested.

The undersigned will consider the rejections chronologically as set forth in the outstanding Office Action beginning at the top of page 2. However, before considering the rejections of record, the Examiner is thanked for the indicated allowability of claims 27, 28, 34, 35 and 38. (See Office Action, page 5, first full paragraph.)

By this amendment the indicated allowable subject matter of claims 27, 28, 34, 35 and 38 appears in independent claims 62, 48, 55 and 71, respectively. Substantially identical claims depend from each of independent claims 48, 55, 62 and 71. Therefore, upon the formal allowance of claims 48, 55, 62 and 71, respective claims 49 through 54, 56 through 61, 63 through 66 and 72 through 75 should be allowed. Stated otherwise, the formal allowance of claims 48 through 66 and 71 through 75 is believed proper and would be most appreciated.

Independent claim 67 is directed to the subject matter of claim 26 which the Examiner "rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's admitted prior art (AAPA) in view of German Patent 629,335 (DE)."

Though the Examiner has approached the rejection of claim 26 in the manner contemplated by Graham v. John Deere Co. of Kansas City, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966), the undersigned emphasizes that with respect to the "three conditions" expressed therein, "**each** must be

"satisfied." More precisely, "Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined." Furthermore, as was stated in Panduit Corp. v. Dennison Manufacturing Co., 1 USPQ2d 1593, 1597, "Among legal standards for determining *scope* and content of the prior art, for example, are: a prior patent must be considered in its entirety, *i.e.*, as a *whole*, including portions that would lead away from the invention in suit." The Panduit court continued by stating "elements of separate prior patents cannot be combined when there is no suggestion of such combination anywhere in those patents." The latter is akin to the hindsight admonition found in many decisions which renders it "impermissible within the framework of Section 103 to pick and choose from any one reference only so much as it as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one skilled in the art." In re Wesslau, 353 F.2d 238, 241, 147 USPQ 391, 393 (CCPA 1965).

With the foregoing in mind, there are two very interesting aspects of the Examiner's approach to the Section 103(a) rejection. These include the Examiner acknowledging that Applicant's admitted prior art (AAPA) involves "a plug/screw combination [which] is inserted into a hole in a fixture, but the hole is oversized with respect to the plug, resulting in the plug being carried only loosely in the hole." Compared to the latter, the Examiner then describes the German patent (DE 629,335) as disclosing a method of "fixing a screw within a hole in brickwork or masonry, the hole in the brickwork

being oversized, preventing the screw from properly anchoring within the hole. The method comprises providing a piece of cotton fabric..., enveloping the screw B... and inserting the envelope screw into the hole... wherein the filler material expands to fill the oversized hole to firmly anchor the screw within the hole." Thus, Applicant's admitted prior art when considered in its entirety, i.e., *as a whole*, **includes a plug**. The German patent, when considered in its entirety, i.e., *as a whole*, **excludes a plug**. How can the secondary German patent, *as a whole*, render the invention of claim 26 obvious when the German patent has nothing to do and does not disclose a plug?! As was stated by the Court of Appeals for the Federal Circuit in In re Gurley, 31 USPQ2d 1130, 1131: "A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant." Certainly the latter is true in the present case because the German secondary patent teaches nothing of a plug and in reality discards the use of a plug and the divergent path thereof taken by Applicant is both the utilization of a plug and enveloping the plug (16) with a piece of fabric (26, 30) which includes hardenable filler material. To the mind of the undersigned, the situation seems rather clear, namely, the Examiner has found elements in separate prior art/prior art patents, and though they have been combined by the Examiner, there certainly is no suggestion of the combination anywhere in these patents. The Examiner states: "It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the filler-containing fabric piece of DE to **envelope the plug** of AAPA to fill the space between the plug and the oversized hole."

The teaching of the DE patent is **not** that of utilizing a fabric piece to envelope a plug, and the Examiner is well aware of the latter fact because he has earlier described the patent to include filler material "enveloping the screw b." Therefore, the teaching of the German patent is that of enveloping a screw, not a plug. Such being the teaching of the secondary patent, where is there a suggestion of wrapping fabric material about a plug? There is no suggestion or motivation in AAPA and there is no suggestion or motivation in the German patent. Having neither suggestion nor motivation in the prior art, might not the Examiner have slipped into the "tempting but forbidden zone of hindsight"? Bausch & Lomb v. Barnes-Hind/Hydrocurve, 230 USPQ 416, 419, citing In re Wesslau, supra.

Even after having acknowledged the clear distinction between the two applied prior art disclosures, the Examiner noted that the "AAPA/DE combination fails to explicitly teach the step of withdrawing the plug from the oversized hole before enveloping the plug with the fabric and re-inserting the plug into the hole." The reason the combination does not explicitly (or otherwise) teach "the step of withdrawing the plug" is because it is a step totally lacking in suggestion in "the AAPA/DE combination" or to a person skilled in the art because of the factual structural differences between the two teachings and the methodology inherently associated therewith. The Examiner is not being "taught" to modify the prior art as stated, but has through hindsight utilized Applicant's disclosure toward an invalid end resulting in the rejection of claim 26 (corresponding claim 67).

With due respect, since the prior art fails to render obvious the subject matter of claim 67, the formal allowance of the latter claim and the claims depending therefrom is believed proper and would be most appreciated.

In view of the foregoing, the formal allowance of this application at an early date would be most appreciated.

Respectfully submitted,

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